THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte JOSEPH W. LANGAN

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Appeal No. 96-0031
Application No. 08/078,918[1]

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ON BRIEF

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Before KIMLIN, PAK and SPIEGEL, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-14. Claims 15-20, the other claims remaining in the present application, stand withdrawn from consideration.

[1]Application for patent filed June 21, 1993. According to appellant, this application is a continuation-in-part of application Serial No. 07/912,851, filed July 13, 1992, now U.S. Patent No. 5,354,588 issued October 11, 1994.

Claims 1 and 2 are illustrative:

1. A stack of cut sheet linerless labels comprising:

> a plurality of linerless labels, each label comprising a substrate having first and second faces, a pressure sensitive adhesive substantially completely covering said first face and a release coat substantially completely covering said second face;
>
> said pressure sensitive adhesive and release coat having an adhesive force between them of between 0.001-1.2 oz/inch, when peeling a one inch by six inch sample at a rate of twelve inches per minute at a ninety degree angle, while being sufficiently tacky to hold the labels together in a stack; and
>
> said labels disposed in a stack with the pressure sensitive adhesive of each label engaging the release coat of the next label below it.

2. A stack of cut sheet linerless labels as recited in claim 1 further comprising a tie coat enhancing adherence of said pressure sensitive adhesive to said substrate, said tie coat adhering to both said substrate first face and said pressure sensitive adhesive.

In the rejection of the appealed claims, the examiner relies upon the following references:

Keeling et al. (Keeling)	3,896,249	Jul. 22, 1975
Fickenscher et al. (Fickenscher)	4,851,383	Jul. 25, 1989

Encyclopedia Of Chemical Technology, Volume 16, "NOISE POLLUTION TO PERFUMES", published 1981 by John Wiley & Sons (NY), pp. 785-792.

Appellant's claimed invention is directed to a stack of cut sheet linerless labels wherein each label comprises a substrate having opposing first and second faces. A pressure sensitive adhesive substantially covers the first face of the substrate, while a release coat substantially covers the second face of the substrate.

Appealed claims 1, 6, 7, 10 and 14 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Keeling. Claims 1, 4, 5, 6, 10, and 12 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Fickenscher. Claims 1, 6-10, 13 and 14 stand rejected under 35 U.S.C. § 103 as being unpatentable over Keeling, while claims 1, 4-6, 8-10, 12 and 13 stand rejected under 35 U.S.C. § 103 as being unpatentable over Fickenscher. In addition, claims 2, 3, and 11 stand rejected under U.S.C. § 103 as being unpatentable over either Keeling or Fickenscher in view of Encyclopedia Of Chemical Technology.

At the outset, we must formally reverse the examiner's rejections of claims 2-5 and 11-14 inasmuch as we find that one of ordinary skill in the art could not reasonably ascertain the scope of these claims. In re Steele, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962). In our view, claims 2-5 and 11-14 are indefinite since they do not

further limit the claims upon which they ultimately depend. For instance, independent claims 1 and 10 require that the opposing faces of the substrate be substantially, completely covered with a pressure sensitive adhesive and a release coat, whereas claims 2-5 and 11-14 recite the provision of different compositions between the pressure sensitive adhesive and the substrate, as well as between the release coat and the substrate. For example, claim 2 recites a tie coat between the substrate and the pressure sensitive adhesive, and claim 4 provides for a thermosensitive layer between the substrate and the release coat. Manifestly, since 35 U.S.C. § 112 requires that a dependent claim "shall be construed to incorporate by reference all the limitations of the claim to which it refers," and must "specify a further limitation of the subject matter claimed," it can not be said that claims 2-5 and 11-14 further limit independent claims 1 and 10 and incorporate the limitations therein pertaining to the pressure sensitive adhesive and release coat substantially completely covering the opposing faces of the substrate.

We will not sustain the examiner's rejections of claims 1, 6, 7, 10 and 14 under 35 U.S.C. § 102(b) over Keeling. As urged by appellant, Keeling fails to disclose the claimed requirement of a substrate having its first and second faces substantially

completely covered with a pressure sensitive adhesive and a release coat, respectively. Rather, Keeling requires that backing 1 have both its faces coated with a release layer. Apparently, the examiner has not given full consideration to the claim limitation that the faces of the substrate are covered with a pressure sensitive adhesive and release coat. We will also not sustain the examiner's rejection under 35 U.S.C. § 103 over Keeling, taken alone, or in view of Encyclopedia Of Chemical Technology. The examiner has not established a prima facie case of obviousness for the claimed subject matter by setting forth a rationale why one of ordinary skill would have found it obvious to modify the structure of Keeling to arrive at the claimed labels which have the opposing faces of a substrate coated with a pressure sensitive adhesive and a release coating.

We will also not sustain the examiner's rejection of claims 1, 4, 5, 6, 10 and 12 under 35 U.S.C. § 102(b) as being anticipated by Fickenscher. As with the Keeling reference, Fickenscher does not describe, within the meaning of §102, a substrate having one face coated with a pressure sensitive adhesive and its opposing face coated with a release coat. In Fickenscher, the release coat 32 is situated on the barrier layer 30, which overlays thermosensitive layer 14. Clearly, Fickenscher fails to describe a release coat substantially completely covering a face of the substrate as

required by the appealed claims. Also, although this is not essential to our holding, we concur with appellant that the examiner errs in finding that barrier layer 30 is a release layer. Fickenscher fails to disclose any release function for the barrier layer, but rather teaches that the barrier layer comprises a composition of a water soluble resin solution which functions to prevent the silicon release layer from discoloring the thermosensitive layer.

We will also not sustain the examiner's rejections under 35 U.S.C. § 103 over Fickenscher, taken alone, or in combination with the Encyclopedia Of Chemical Technology. The examiner has not established that it would have been obvious for one of ordinary skill in the art to modify Fickenscher to substantially completely cover the face of substrate 12 with release coating 32.

Under the provisions of 37 C.F.R. § 1.196(b), we enter the following new ground of rejection. Claims 2-5 and 11-14 are rejected under 35 U.S.C. § 112. As explained above, these claims are improper dependent claims insofar as they do not further limit the independent claims upon which they ultimately depend. For example, we are unable to ascertain the scope of claim 4 when it is read in conjunction with claim 1, upon which it depends.

In conclusion, based on the foregoing, the examiner's rejections of the appealed claims are reversed. A new ground of rejection has been entered under 37 C.F.R. § 1.196(b) of claims 2-5 and 11-14.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 C.F.R. § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 C.F.R. § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

> (1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .
>
> (2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

REVERSED
§1.196(b)

EDWARD C. KIMLIN Administrative Patent Judge	)	
CHUNG K. PAK Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
CAROL A. SPIEGEL Administrative Patent Judge	)	

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